No. 75-1566

Supreme Court, U.S.
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In the Supreme Court of the United States

OCTOBER TERM, 1975

LESLIE CATRON CASE, PETITIONER

v.

COMMISSIONER OF PATENTS AND TRADEMARKS, ET AL.

ON MOTION FOR LEAVE TO FILE AN EXTRAORDINARY WRIT AND PETITION FOR AN EXTRAORDINARY WRIT TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

MEMORANDUM FOR THE COMMISSIONER OF PATENTS AND TRADEMARKS IN OPPOSITION

ROBERT H. BORK,
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Washington, D.C. 20530.

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1. On April 26, 1973, the board of patent interferences in the United States Patent Office commenced a proceeding to determine whether petitioner or CPC International, Inc. had priority with respect to a certain patent (Pet. 6). On May 9, 1975, petitioner moved to take interrogatories of CPC International personnel, and filed with the board a report enumerating various alleged "discrepancies and contradictions in the sworn record of CPC International" (Pet. 7). The board denied the motion and declined to take action on the report.

Petitioner thereupon commenced this suit in the United States District Court for the District of Massachusetts against the Commissioner of Patents and Trademarks and CPC International, Inc., seeking a writ of

mandamus to compel the Commissioner to grant petitioner's motion to take interrogatories and to take notice of the alleged discrepancies. The district court dismissed the action (Pet. 8). The court of appeals affirmed, on the ground that petitioner's complaint, although framed in terms of mandamus, sought judicial review of an interlocutory decision of the Patent Office (Pet. App.).

2. The court of appeals correctly affirmed the dismissal of this action. Although 35 U.S.C. 146 gives the district courts jurisdiction to review final decisions of the board of patent interferences on questions of priority, it does not authorize review of interlocutory decisions of the board. Cf. *Sanford* v. *Kepner*, 344 U.S. 13; *Phillips Petroleum Company* v. *Brenner*, 383 F.2d 514 (C.A.D.C.). As petitioner concedes (Pet. 11), the interference proceeding at issue has not yet been terminated, and the board has issued no final decision on priority. Accordingly, the district court was without jurisdiction.

In any event, neither the board nor the Commissioner has a mandatory duty to require interrogatories in a patent interference proceeding, or to investigate charges of fraud.[1] Accordingly, mandamus will not lie.

[1] *Precision Instrument Manufacturing Company* v. *Automotive Maintenance Machinery Co.*, 324 U.S. 806, upon which petitioner relies, is inapposite, since the Court held there only that the failure of a party to Patent Office proceedings to report to the Office all facts concerning possible fraud underlying the applications at issue barred that party from seeking equitable relief in a subsequent suit for infringement of the patent.

It is therefore respectfully submitted that the motion for leave to file an extraordinary writ and petition for an extraordinary writ should be denied.

ROBERT H. BORK,
Solicitor General.

JUNE 1976.